

REMARKS

The Final Office Action mailed June 23, 2008, has been received and reviewed. As of the June 23, 2008 Office Action, Claims 1-4, 6-13, 15-25 and 27-31 were pending and presently stand rejected. Additionally, the Examiner has objected to Claims 4, 11 and 12. Applicant has amended Claims 1, 4, 11-12, 17-18, 25 and 29 herein. Applicant has added two new Claims 32-33. As of this AMENDMENT B, Claims 1-4, 6-13, 15-25 and 27-33 are believed to be in condition for allowance and Applicant respectfully requests reconsideration of the application as amended herein.

Claim Objections

The Examiner has objected to Claim 4 because of improper dependency. Applicant has amended Claim 4 to depend from Claim 3. The Examiner has further objected to Applicant's use of trademark symbols in Claims 11-12.

Applicant has studied the current list of Microsoft Corporation trademarks, both registered and common law, as suggested by the Examiner. The list of Microsoft® trademarks, both registered and common law, appears to suggest that Microsoft® considers the individual terms "Windows", "Word" and "Project" to be neither registered (®) nor considered common law trademarks (™). However, Microsoft Corporation holds two active trademark registrations for the mark "Microsoft Windows", see, Registration Nos. 1,959,130 and 2,285,870. Additionally, Microsoft Corporation holds at least one active registration for the mark "Microsoft", see Registration No. 2,285,870. Similarly, Microsoft Corporation holds a trademark registration for "Excel", see Registration No. 2,942,050. In view of these registrations, Applicant asserts that "MICROSOFT®", "MICROSOFT WINDOWS®" and "EXCEL®" are registered trademarks of Microsoft Corporation.

In view of this analysis and suggested practice in M.P.E.P § 608.01(v), Applicant has amended Claims 11 and 12 to capitalize and append the ® symbol to known trademarks of Microsoft Corporation.

Similarly, with regard to Applicant's use of the term POST-IT® note, Applicant has amended Claims 1, 17, 18, 25 and 29 to use the generic descriptive term

“adhesive-backed paper note” in place of “POST-IT® note”, in order to avoid any trademark misuse.

35 U.S.C. § 103(a) Obviousness Rejections

The Supreme Court in *KSR International Co. v. Teleflex Inc.*, reaffirmed the objective analysis for determining obviousness under 35 U.S.C. § 103: “[T]he scope and content of the prior art are . . . determined; differences between the prior art and the claims at issue are . . . ascertained; and the level of ordinary skill in the pertinent art resolved.” 127 S.Ct. 1727, 1729-30, (U.S. 2007) (quoting *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966)).

M.P.E.P. 706.02(j) sets forth the contents of a Section 103(a) rejection:

To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

Ex parte Clap, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985).

Obviousness Rejection Based on U.S. Patent No. 6,056,195 to Spain in view of U.S. Patent Application Publication No. 2004/0153969 to Rhodes in view of U.S. Patent No. 5,682,695 to Hoffman in further view of U.S. Patent Application Publication No. 2002/0073168 to Riley et al.

The Examiner has rejected Claims 1-4, 6-12 and 29-31 under 35 U.S.C. § 103(a) as being unpatentable over Spain in view of Rhodes in view of Hoffman in further view of Riley et al.

The Examiner asserts that Spain discloses “generating a note from each of the discrete portions of information, wherein each note includes visually perceptible note information and a duplicate computer readable symbology of the note information”, citing to Spain, FIG. 1A, Office Action, page 3, ¶ 10. However, careful review of FIG. 1A will reveal that Spain discloses generation of a UPC label 1 comprising a bar code 2 identifying a product by a serial number and including text describing the goods written in a couple of languages. Col. 1:22-34. FIG. 1B of Spain illustrates a compliance label 5 including a UPC bar code 6 for identifying a product, a second bar code 7 encoding

shipping information and descriptive text, e.g., goods description and quantity, in two different languages 8 and 9.

The labels shown in FIGS. 1A and 1B of Spain do not disclose what is claimed in Claim 1. For example, if the discrete portion of information is: "perform task A", the note according to Claim 1 would include text: "perform task A", which is "visually perceptible note information". Additionally, the note includes a bar code encoding the duplicate text: "perform task A", i.e., "a duplicate computer readable symbology of the note information" as recited in Claim 1. The UPC bar codes shown in FIGS. 1A and 1B of Spain are simply serial numbers related to the goods to which they are attached, see Col. 1:53-54. While a serial number in the UPC bar code may be associated with a particular good, it is not duplicative of the text displayed elsewhere on the labels in FIGS. 1A and 1B. Similarly, the second bar code shown in FIG. 1B encodes shipping information that is not duplicative of any "visually perceptible note information", i.e., text. For these reasons, Spain fails to disclose the limitation: "wherein each note includes visually perceptible note information and a duplicate computer readable symbology of the note information", recited in Claim 1.

Applicant further asserts that the intended application of Spain teaches away from the use of an adhesive-backed paper note because a an adhesive-backed paper note is configured to be removable, whereas the product labels taught by Spain are configured to be permanently attached to the goods on which they are attached.

The problem solved by Spain is simply to print packaging or goods labels with barcodes in multiple languages. The barcodes disclosed are duplicative of text written elsewhere on the Spain labels. Applicant asserts that the Spain labels were never intended to be used in the context of "generating and organizing information in a meeting". The information printed on Spain labels is static and preselected based on the goods, barcode standards and the languages chosen. Whereas the information gathered and organized during a meeting in the context of the present invention is dynamic and based entirely on the information generated during the meeting. Finally, there is neither disclosure nor suggestion that the labels generated in Spain are printed on Post-It® note media, moved to and organized in a selected repository, scanned and

then placed into a selected computer software application as in the present invention.

The Examiner asserts that it would have been obvious at the time of the invention to have included the use of the printed barcode labels in a meeting environment, as disclosed by Rhodes in the system disclosed by Spain. Office Action p. 4, ¶ 13. The Examiner asserts that the motivation for doing so is "providing an additional use of barcoded labels." *Id.* As noted above, the barcodes of Spain do not meet the limitations of Claim 1. Further analysis of the barcodes of Rhodes follows.

Based on Applicant's understanding of the cited portions of Rhodes, it appears that the Rhodes barcodes are used to index portions of information that a user would like to integrate into the user's notes. The Rhodes barcodes do not appear to be a "duplicate computer readable symbology of the note information" as recited in Claim 1. Rather, the Rhodes "barcode may also be used to represent the indexing information. The barcode may be placed next to the static visual representation corresponding to the barcode." ¶ [0116]. Applicant notes that even if Rhodes teaches the use of barcodes in the context of a meeting, that use is simply as a means of indexing information presented to the user for selected insertion into the user's own notes. Rhodes does not teach barcodes that are "a duplicate computer readable symbology of the note information" as recited in previously amended Claim 1.

The problem solved by the Rhodes is integrating multimedia presentation information into a set of user notes. Rhodes does not disclose the generation of notes with user information in text and a duplicate of the text in a barcode. Rather, Rhodes allows a user to take notes by hand and then augment those notes with multimedia at selected points within the user's notes. The barcodes disclosed in Rhodes are not duplicative of "discrete portions of information" content of the present invention. Rather, the barcodes in Rhodes are merely used as an index to the multimedia content that is selectively inserted into the user's notes. Like Spain, Rhodes neither discloses nor suggests that user generated content may be duplicated in a barcode, printed on Post-It® note media, moved to and organized in a selected repository, scanned and then placed into a selected computer software application as in the present invention. Though the invention of Rhodes is intended for use during a meeting, it fails to meet all

the limitations of previously amended Claim 1.

For these reasons, Applicant asserts that neither Spain nor Rhodes, alone or in combination, appears to disclose a “method for generating and organizing information in a meeting, comprising . . . generating a note from each of the discrete portions of information, wherein each note includes visually perceptible note information and a duplicate computer readable symbology of the note information”, as recited in previously amended Claim 1.

The Examiner further asserts that “it would have been obvious to one of ordinary skill in the art at the time of the invention to have included organizing notes on a clipboard, as disclosed by Hoffman, in the system of Rhodes for the motivation of providing a means for presenting information in a meeting.” Office Action, p. 4, ¶ 15. Applicant acknowledges that use of walls, bulletin boards, or clip boards to manipulate adhesive-backed notes that are hand-written” or preprinted is well known in the prior art.

However, Hoffman neither discloses nor suggests “generating a note from each of the discrete portions of information, wherein each note includes visually perceptible note information **and a duplicate computer readable symbology of the note information**”, as recited in previously amended Claim 1, emphasis added. Rather, Hoffman is silent as to the use of barcodes altogether.

The Hoffman reference is perhaps the closest to the actual intended application of the present invention. But, Hoffman merely provides a portable note organizer. There is neither disclosure nor suggestion of using user generated and printable notes as recited in Claim 1. Furthermore, there is neither disclosure nor suggestion that a user could barcode the discrete portions of information to generate notes with duplicate information, print the notes on Post-It® note media, scan and then place the barcode information into a selected computer software application as in the present invention. Thus, neither Spain nor Rhodes nor Hoffman appears to disclose a “method for generating and organizing information in a meeting, comprising . . . generating a note from each of the discrete portions of information, wherein each note includes visually perceptible note information and a duplicate computer readable symbology of the note

information”, as recited in previously amended Claim 1.

The Examiner further asserts and Applicant acknowledges that printing and reading barcodes on a Post-It® note is known in the prior art, see Riley et al., ¶¶ [0009] and [0017]. The Examiner asserts that “it would have been obvious to one of ordinary skill in the art at the time of the invention to have included printed Post-It® notes, as disclosed by Riley, in the system of Hoffman for the motivation of providing information for display on the clipboard.” Office Action, p. 4, ¶ 17.

However, it is apparent that the barcode printed on Post-It® note according to the teachings of Riley et al. is merely an identification code associated with a particular page of a website that upon reading, for example with a barcode reader, “will automatically activate the indicated website page.” Riley et al., ¶¶ [0007] and [0015]. Thus, the Riley et al. barcode is not “a duplicate computer readable symbology of the note information” as recited in previously amended Claim 1.

The Riley et al. reference discloses a solution to the problem of linking a multimedia message to a physical object. Though Riley et al. discloses printing barcodes on Post-It® note media, the barcode information is not duplicative of the message information. In fact, the barcode of Riley et al. is simply an identification link to a website.

Applicant reiterates that none of the references cited in the Final Office Action disclose or suggest a note having duplicate “discrete portions of information” on the note itself, namely a “visually perceptible note information (text) and a duplicate computer readable symbology of the note information (barcode)” as recited in previously amended Claim 1. Thus, Applicant traverses the Examiner’s assertion that “the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.”

The purpose of Applicant’s invention is to be able to generate printed Post-It® notes for use in brain-storming sessions or other meetings where a group of people are generating ideas or planning tasks to accomplish a common goal. Applicant’s notes are

novel and nonobvious because of the duplicate information that is included on each note in the form of a barcode. The visually perceptible information (text) is readily viewable by users of the inventive method. The duplicate computer readable symbology of the note information (barcode) allows the user to gather information from the notes in any order and pull that information into an application by scanning for further processing.

Claims 2-4, 6-12 depend from amended Claim 1, and thus are believed to be allowable for the same reasons. Similarly, previously amended Claim 29 includes the same novel limitation as previously amended Claim 1, namely: "generating a note from each of the discrete portions of information, wherein each note includes a visually perceptible version of the discrete portion of information and a duplicate computer readable symbology of the discrete portion of the information". Claims 30-31 depend from previously amended Claim 29, and are thus believed to be allowable for the same reasons as previously amended Claim 1.

For all of these reasons, Applicant respectfully requests reconsideration of the obviousness rejection of Claims 1-4, 6-12 and 29-31 based on Spain, Rhodes, Hoffman and Riley et al.

Obviousness Rejection Based on U.S. Patent No. 6,056,195 to Spain in view of U.S. Patent Application Publication No. 2004/0153969 to Rhodes

The Examiner has rejected Claims 13, 15-16 and 19-24 under 35 U.S.C. § 103(a) as being unpatentable over Spain in view of Rhodes. More specifically, the Examiner asserts that Spain discloses: "receiving discrete portions of information using the computer keyboard and formatting each of the discrete portions of information as an output, wherein each output includes a visually perceptible version of each discrete portion of the information and a duplicate computer readable symbology of each discrete portion of the information" as recited in previously amended Claim 13.

However, Applicant asserts that neither Spain nor Rhodes discloses "wherein each output includes a visually perceptible version of each discrete portion of the information and a duplicate computer readable symbology of each discrete portion of

the information". The barcodes of neither reference are "a duplicate computer readable symbology of each discrete portion of the information". There would simply be no reason to include "a duplicate computer readable symbology of each discrete portion of the information" in the barcodes disclosed in Spain, because the Spain barcodes serve a different purpose.

The UPC barcodes shown in FIGS. 1A and 1B of Spain, are simply serial numbers related to the goods to which they are attached, see Col. 1:53-54. While a serial number in the UPC barcode may be associated with a particular good, it is not duplicative of the text displayed elsewhere on the labels in FIGS. 1A and 1B. Similarly, the second barcode shown in FIG. 1B encodes shipping information that is not duplicative of any "visually perceptible note information", *i.e.*, text.

Similarly, there would be no reason for the barcodes disclosed in Rhodes to include "a duplicate computer readable symbology of each discrete portion of the information", because the Rhodes barcodes serve a different purpose. The barcodes disclosed in Rhodes "represent indexing information" relative to the multimedia excerpts used to augment the user notes. More specifically, the Rhodes "barcode may also be used to represent the indexing information. The barcode may be placed next to the static visual representation corresponding to the barcode." ¶ [0116]. But, it is not duplicative of the discrete portion of the information as recited in previously amended Claim 13.

Claims 15-16, 19-24 all depend from previously amended Claim 13, and are thus believed to be allowable over Spain and Rhodes for the same reasons as previously amended Claim 13.

Obviousness Rejection Based on U.S. Patent No. 6,056,195 to Spain in view of U.S. Patent Application Publication No. 2004/0153969 to Rhodes in further view of U.S. Patent Application Publication No. 2002/0073168 to Riley et al.

Claims 17, 25 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Spain, Rhodes and Riley et al. As noted above, Applicant asserts that Spain and Rhodes fail to disclose or suggest all of the limitations of previously amended Claim 13. Though Riley et al. discloses printing barcodes on a Post-It® note,

it is evident that Riley et al. does not disclose or suggest “a duplicate computer readable symbology of each discrete portion of the information” as recited in previously amended Claim 13, see arguments above.

Applicant further asserts that one of skill in the art would find no reason or suggestion to include “a duplicate computer readable symbology of each discrete portion of the information” in the barcode of Riley et al. This is because the barcode of Riley et al. is configured for a very specific purpose, namely, an identification code associated with a particular page of a website that upon reading, “will automatically activate the indicated website page.” Riley et al., ¶¶ [0007] and [0015]. Thus, the Riley et al. barcode is not “a duplicate computer readable symbology of each discrete portion of the information” as recited in previously amended Claim 13.

Previously amended Claim 25 recites a “system for generating and organizing information in a meeting, comprising: . . . generating an output comprising the information and a duplicate computer readable symbology of the information”. This limitation is not found in any of the cited references. Applicant has reviewed the cited portions of the cited references and cannot find disclosure or suggestion of this limitation. Therefore, Application requests clarification regarding where in Spain, Rhodes or Riley et al. this limitation may be found.

Claim 28 depends from previously amended Claim 25, and is thus believed to be nonobvious over the asserted combination of Spain, Rhodes and Riley et al. for the same reasons as Claim 25. Applicant respectfully requests reconsideration of the obviousness rejection of Claims 17, 25 and 28 over Spain in view of Rhodes and further in view of Riley et al.

Obviousness Rejection Based on U.S. Patent No. 6,056,195 to Spain in view of U.S. Patent Application Publication No. 2004/0153969 to Rhodes in view of U.S. Patent Application Publication No. 2002/0073168 to Riley et al. in further view of U.S. Patent No. 5,682,695 to Hoffman

Claims 18 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Spain in view of Rhodes in view of Riley et al. and in further view of Hoffman.

Claim 18 depends from Claim 17, which depends in turn from Claim 16, which in turn depends from Claim 15, which in turn depends from Claim 13. Therefore, Claim 18 includes all of the limitations of Claims 13 and 15-17.

As noted above, neither Spain nor Rhodes nor Riley et al. nor Hoffman discloses “wherein each output includes a visually perceptible version of each discrete portion of the information and a duplicate computer readable symbology of each discrete portion of the information” as recited in previously amended Claim 13. Thus, Applicant seeks further clarification from the Examiner regarding where such disclosure may be found in the cited prior art.

Similarly, Applicant has already argued the nonobviousness of previously amended Claim 25 from which Claim 27 depends. Applicant has reviewed all of the cited portions of each of the four cited prior art references and cannot find disclosure of the limitation: “generating an output comprising the information and a duplicate computer readable symbology of the information”. This limitation is not found in any of the cited references. For this reason, Claim 27 is believed to be nonobvious as well.

For all of these reasons, Applicant respectfully requests reconsideration of the obviousness rejection of Claims 18 and 27 over Spain in view of Rhodes in view of Riley et al. and in further view of Hoffman.

New Claims 32-33

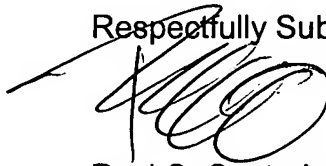
New Claims 32-33 depend from original Claim 7 and merely claim specific embodiments of original Claim 7. No new matter has been added. For this reason, New Claims 32-33 do not require the Examiner to perform a new search for relevant prior art.

CONCLUSION

Claims 1-4, 6-13, 15-25 and 27-33, are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicant's undersigned attorney.

The Commissioner is hereby authorized to charge any additional fee or to credit any overpayment in connection with this Amendment to Deposit Account No. 50-0881.

Respectfully Submitted,



Paul C. Oestreich
Registration Number 44,983
Attorney for Applicant
MORRISS O'BRYANT COMPAGNI, P.C.
734 East 200 South
Salt Lake City, Utah 84102-2202
(801) 478-0071 Telephone
(801) 478-0076 Facsimile

PCO/st